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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,987	12/05/2003	Dickory Rudduck	112427.132US1	7249
28089	7590	04/05/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			YIP, WINNIE S	
399 PARK AVENUE			ART UNIT	
NEW YORK, NY 10022			PAPER NUMBER	

3636

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,987	RUDDUCK ET AL.	
	Examiner	Art Unit	
	Winnie Yip	3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,30,31,33-38,40-44,46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31,40-44,46 and 47 is/are rejected.
- 7) ☒ Claim(s) 33-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/17/06 & 9/16/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first office action for a Request for Continued Examination application (RCE), filed January 17, 2006, of earlier application.

Claims 7-29, 32 and 39 have been canceled, and claims 1-6 and 30 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 19, 2004.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

1. Receipt is acknowledged of certified copies of foreign priority documents submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

2. Claim 42 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 41. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. Claims 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 40 recites the limitation "the co-operating means" in the joining clip.

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There is insufficient antecedent basis for this limitation in the claim. Notice, the features “a co-operating means” only functionally recited in the previous claim 31 for intended use only, and the feature is not positively claimed.

Notice, as the scope of claimed invention, claims 40-44 and 46-47 are only treated as “a joining clip” on the merits.

Claim Rejections - 35 USC § 102

4. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Marcel (European Patent No. 1022,403).

Marcel teaches a building element (3) being used for a stud or mullion (see Fig. 1), the building element (3) (see Fig. 6) comprising: a first and second sets of three channels each formed by a pair of substantially parallel side walls (11, 15; 15, 15; 15, 11) and a base (14) formed therebetween, the bases of each first and second sets of channels being aligned, the side walls of the first set of channels being also parallel to the side walls of the second set of channels, the first and second sets of channels being spaced apart from one to other by two substantially parallel webs (sides between elements 28 or 29), wherein the building element is capably used as a stud (see Fig. 1) with the sets of channels being opened outwardly in opposite directions, and the channel side walls formed by resilient arms for capably receiving a co-operating means such as an elongated clip (6) for mounting a panel (7) or bracket on the building element, and wherein the building element is a unitary structure.

5. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Lieber (Australia Patent No. 55877).

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Lieber teaches a building element (1) being used for a stud or mullion, the building element (1) may include two arms being connected to the building element at an angle of 90 degree (see and lied in one plane (see corner arrangement in Fig 2), or may have three arms to form a T shape configuration (see top and bottom arrangement in Fig.2); the building element (1 or 2) being a unitary structure and comprising: a first and second sets of three channels (11) each formed by a pair of substantially parallel side walls (10) and a base formed therebetween, the bases of each first and second sets of channels being aligned, the side walls of the first set of channels being also parallel to the side walls of the second set of channels, the first and second sets of channels being spaced apart from one to other by two substantially parallel webs (36), wherein the building element is capably used as a stud (see Fig. 2) with the sets of channels being opened outwardly in opposite directions, and the channel side walls formed by resilient arms for capably receiving a co-operating means for mounting a panel (17) or bracket on the building element.

6. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Schneider (US Patent No.6,003,279).

Schneider teaches a building element (16 or 36) being used for a stud or mullion, the building element (16 or 36) (see Figs. 2 and 8A) comprising: a first and second sets of three channels (30, 31, 32) each formed by a pair of substantially parallel side walls (40, 24, 23, 24') and a base formed therebetween, the bases of each first and second sets of channels being aligned to form a base wall (42), the side walls of the first set of channels being also parallel to the side walls of the second set of channels, the first and second sets of channels being spaced

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apart from one to other by two substantially parallel webs, wherein the channel side walls is capable to receive a co-operating means such as an elongated clip (83) for mounting a panel (5 or 4) or bracket on the building element therein, and wherein the building element is a unitary structure.

7. Claims 40-44 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US Patent No. 3,053,353).

Miller shows and discloses a building element used for a mullion, the building element (i.e., 16) including at least one set of three channels, each channel formed by an aligned base (44) and two adjacent sides (46, 56, 54, 48), the adjacent sides having protrusions (50, 56, 54, 50) for receiving a co-operating means, a joining clip being made of metal and including two separated parts (40, 42) including a first longitudinally extending part (42) and a second longitudinally extending part (40), wherein the second longitudinally extending part (42) includes a pair of resilient arms (78, 80) having protrusions to snap or slide into the channels in the building element (16) to provide co-operating means for mounting a panel (22) to the building element, the second longitudinally extending part (40) further includes a channel formed by side walls (74, 76), the second extending part (40) includes two resilient arms (62, 64) having protrusions for snapping into the channel on the first longitudinally extending part (42) to mate with the first longitudinally extending part, and the second longitudinally extending part (40) includes two engaging flanges (72, 70) with engaging surfaces (72) providing a seal between the joining clip with the panels for providing means for connecting the joining clip to the panel as claimed.

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Notice, these claims only claim a joining clip, the structure of the building element as cited on claim 31 is not part of the claimed invention and as give a very little patentable weight thereon.

Claim Rejections - 35 USC § 103

8. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US Patent No. 3,053,353) as applied to claim 40 above.

The claim is considered to meet by Miller as explained and applied above rejection except that Miller does not define the joining clip being specifically made of stainless steel, however, since the applicant has not disclosed that the specific type of material solves any stated problem it appears that claimed invention, the joining clip of Miller would be performed equally well made of stainless steel instead of aluminum as claimed as an obvious matter of design choice to take same function of the metal properties such as having sufficient impact strength characterizes, durable and weather and moisture resistant with minimum maintenance requirements characterizes. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art.

Allowable Subject Matter

9. Claims 33-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Argument

10. Applicant's arguments, filed January 17, 2006, with respect to the rejections of claims under 35 U.S.C. 102 by references to Rinaldi, Pollard, and Gassler have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new grounds of rejection is made as set forth above.

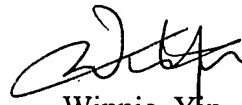
11. In response to applicant's argument that Miller '353 fails to teach the frame member 16 including two sets of three channels as recited in claim 31 as now amended, the recitation of building element has not been given many patentable weight because the recitation occurs in the preamble. Notice, claims 40-44 and 46-47 only claim a joining clip being intended use to a building element as recited in claim 31, but not a combination including a building element. Therefore, whether or not the building element of Miller having two sets of three channels is not part of the claimed invention. Miller teaches a building element including channels, and a joint clip as claimed that is capably snapped into the channel of the building element, therefore, the joining clip of Miller is considered to be capable used to stand alone for a building element including two sets of three channels as cited in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the rejection still granted.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip
Primary Examiner
Art Unit 3636

wsy
March 30, 2006